

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte PHILIP F. FOX

Appeal No. 2005-0665
Application No. 09/502,701

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed March 25, 2003) of claims 1 to 43, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to an apparatus for storing ice fishing equipment (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Morin	4,311,262	Jan. 19, 1982
Wolniak	4,827,658	May 9, 1989
McEwen	5,131,179	July 21, 1992
Thibodeaux	6,185,860	Feb. 13, 2001

The rejections under appeal as set forth in the final rejection are:

1. Claims 1, 2, 7 to 9 and 24 to 26 under 35 U.S.C. § 102(e) as being anticipated by Thibodeaux.
2. Claims 10 to 15, 17, 18, 30 to 34, 37 and 38 under 35 U.S.C. § 102(b) as being anticipated by Wolniak.
3. Claims 19, 21 to 23, 39 and 41 under 35 U.S.C. § 102(b) as being anticipated by McEwen.
4. Claim 3 under 35 U.S.C. § 103 as being unpatentable over Thibodeaux in view of Morin.

5. Claims 27 to 29 under 35 U.S.C. § 103 as being unpatentable over Thibodeaux.
6. Claims 1, 4 to 6, 16 and 43 under 35 U.S.C. § 103 as being unpatentable over Wolniak in view of Thibodeaux.
7. Claim 20 under 35 U.S.C. § 103 as being unpatentable over McEwen.
8. Claims 35 and 36 under 35 U.S.C. § 103 as being unpatentable over Wolniak.
9. Claims 40 and 42 under 35 U.S.C. § 103 as being unpatentable over McEwen in view of Wolniak.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and the answer (mailed August 5, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed September 25, 2003) and reply brief (filed October 5, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Rejection 1

We will not sustain the rejection of claims 1, 2, 7 to 9 and 24 to 26 under 35 U.S.C. § 102(e) as being anticipated by Thibodeaux.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 1 reads as follows:

An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of extendable elongate shells, the extendable elongate shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell;
and

a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.

Thibodeaux's invention relates to a fisherman's cooler. As shown in Figure 1, the cooler includes a box-shaped container 1 having a pivotable lid 6 for covering a substantially open top portion. The lid includes an indented portion 7 on its upper surface having measuring indicia 11 therein for assisting a fisherman in measuring a fish. The top portion of the container includes a plurality of fishing rod holders 10, the diameter of which may be varied to support varying diameter fishing rods. Figure 4 is a perspective **exploded** view of a fishing rod holder. Thibodeaux teaches (column 2, lines 35-49) that:

On the top portion of the container, adjacent each corner thereof, is a fishing rod holder 10 which may be selectively configured to fit varying diameter rods. Each fishing rod holder 10 includes a plurality of concentric cup members 12 of varying diameter which may be added and removed as necessary depending upon the diameter of the fishing rod. Each cup member includes a longitudinal U-shaped groove 13 along its inner surface that forms a U-shaped protrusion 14 on its outer surface. Each U-shaped groove on a cup member receives the exterior protrusion on the cup member received therein for preventing each cup member from rotating relative to the others. The largest outermost cup member is received within a bore on the top portion of the container. The bore also includes a U-shaped groove therein for locking the outermost cup member.

Claim 1 is not anticipated by Thibodeaux. In that regard, Thibodeaux does not disclose a pair of extendable elongate shells as recited in claim 1. Each fishing rod holder 10 of Thibodeaux consists of a plurality of concentric cup members 12 of varying diameter which collapse inside one another wherein the concentric cup members may be added and removed as necessary depending upon the diameter of the fishing rod. Figure 4 of Thibodeaux does not illustrate that the concentric cup members form an extendable elongate shells but instead illustrates in a perspective **exploded** view of a fishing rod holder that the concentric cup members collapse to fit inside one another.

For the reasons set forth above claim 1 is not anticipated by Thibodeaux. Accordingly, the decision of the examiner to reject claim 1, and claims 2, 7 to 9 and 24 to 26 dependent thereon, under 35 U.S.C. § 102(e) as being anticipated by Thibodeaux is reversed.

Rejection 2

We will not sustain the rejection of claims 10 to 15, 17, 18, 30 to 34, 37 and 38 under 35 U.S.C. § 102(b) as being anticipated by Wolniak.

Independent claims 10, 30, 32 to 34 and 37 read as follows:

10. An ice fishing tackle storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, at least one of the elongate cavities having a length that is adequate to accept a portion of an ice fishing rod within the at least one elongate cavity, the ice fishing rod having a tip and a handle, a reel or a line windup attached to the ice fishing rod proximate the handle, the portion of the ice fishing rod extending from a tip of the ice fishing rod to the reel or line windup;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.
30. An ice fishing rod storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing rods capable of being individually positioned within the elongate cavities of the different elongate shells;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.
32. An ice fishing tackle storage apparatus, the apparatus comprising:
 - a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and
 - a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
 - wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising a one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the

elongate shells passing through the aperture of the wall or positioned in the recess of the wall.

33. An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the apparatus further comprising a socket, the socket attached to the wall of the container, and one of the elongate shells positioned in the socket.

34. An ice fishing tackle storage system, the ice fishing tackle storage system comprising an ice fishing storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a first wall, the first wall attached to the first spacing component; and
a container, the ice fishing tackle storage apparatus positioned in the container, the container having a second wall, the first wall and the second wall defining a chamber within the container, an ice fishing tip-up capable of being placed in the chamber.

37. An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; the elongate shells each having both a distal end and a proximal end;
a first spacing component, the pair of elongate shells each secured by the first spacing component, the first spacing component having a distal surface and a proximal surface; and

a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;

wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a closed bottom end and an open upper end, the first spacing component positioned at the open upper end.

Wolniak's invention relates to a fishing tackle box for storing artificial lures.

Figures 1-2 show a fishing tackle box constructed in accordance with Wolniak's invention. The tackle box includes a container or base portion 10 having two side walls 11, two end walls 12 and a bottom panel 13. The bottom panel 13 is formed with a plurality of holes 23 therethrough which are formed to be positioned within the interior of each one of a plurality of vertically disposed display tubes 30, so that water dripping from the lures can pass out from the tackle box and air can circulate through to dry the lure. The container portion 10 has a lip 14 formed about the opening defined by the walls 11 and 12 which functions to strengthen this portion of the container 10 and to engage with a top or closure portion 20. The top or closure portion 20 is formed as two halves 20a and 20b with each of the halves being joined to one of the side walls 11 by a hinge connection 16 which permits the closure or cover portions 20a and 20b to be pivoted between an open or display position, such as illustrated by 20a, and a closed position (not illustrated).

As best illustrated in Figures 1 and 2, a layer or panel 21 of flotation material, such as an expanded rigid polystyrene plastic, is positioned at the bottom of the container portion 10 against the inner surface of the bottom panel 13, and has holes 22 formed therein which correspond to the size of vertically disposed display tubes 30. The display tubes 30 are secured in the holes formed in the flotation material, and extend upwardly therefrom. A second or upper band or panel of flotation material 26 is positioned within the container portion 10 of the tackle box just beneath the lip portion 14 formed about the open peripheral edge thereof. This second band of flotation material is also formed with a plurality of holes 22 therein through which the vertically disposed plastic display tubes 30 are passed. In this manner, the vertically disposed plastic display tubes 30 are oriented in a proper position, and held in this manner between the two flotation material panels 21 and 26. These flotation panels, preferably, are secured to the inner surfaces of the side walls 11, end walls 12 and/or the bottom panel 13. Wolniak teaches (column 3, lines 52-58) that:

The flotation material, however, does not have to be secured in this manner, and if the tubes are secured in the holes formed in the flotation material without the flotation material being secured to the container portion 10, the entire tube display assembly may be lifted from the container portion, if desired.

As illustrated in Figure 3, the vertically disposed display tubes 30 are preferably made from a transparent plastic material which permits the fishing lures positioned

therein to be seen through the material from which the plastic display tubes are formed. A series of slots 31 may be formed in the upper end of the vertically disposed display tubes 30 to permit a hook from a fishing lure to be positioned in the slot 31 to retain the lure in a proper orientation. In this manner, also, more than one lure can be contained in an individual display tube 30 by positioning the lure in the tube with a hook engaging one of the slots 31.

Claim 10 is not anticipated by Wolniak. In that regard, the lengths of the display tubes 30 are not taught by Wolniak. As such, the claimed length (i.e., a length adequate to accept the portion of an ice fishing rod extending from a tip of the ice fishing rod to the reel or line windup) is not disclosed by Wolniak. It is well-settled that under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)(quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the

disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

It is not clear that the claimed length is necessarily present in Wolniak and that it would be so recognized by persons of ordinary skill.

For the reason set forth above claim 10 is not anticipated by Wolniak.

Accordingly, the decision of the examiner to reject claim 10, and claims 11 to 15, 17 and 18 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Claim 30 is not anticipated by Wolniak. In that regard, Wolniak does not disclose that ice fishing rods are capable of being individually positioned within the display tubes 30. As such, the claimed shells are not disclosed by Wolniak. It is not clear that the claimed elongate cavities capable of receiving ice fishing rods is necessarily present in Wolniak and that it would be so recognized by persons of ordinary skill.

For the reason set forth above claim 30 is not anticipated by Wolniak.

Accordingly, the decision of the examiner to reject claim 30, and claim 31 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Claim 32 is not anticipated by Wolniak. In that regard, Wolniak does not disclose a wall comprising one or more interior surfaces that define a recess in the wall or an aperture through the wall wherein the second spacing component comprises the recess or the aperture and one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall. As such, the claimed ice fishing tackle storage apparatus is not disclosed by Wolniak.

For the reason set forth above claim 32 is not anticipated by Wolniak.

Accordingly, the decision of the examiner to reject claim 32 under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Claim 33 is not anticipated by Wolniak. In that regard, Wolniak does not disclose a socket attached to the wall of the container wherein one of the elongate shells is positioned in the socket. As such, the claimed ice fishing tackle storage apparatus is not disclosed by Wolniak.

For the reason set forth above claim 33 is not anticipated by Wolniak. Accordingly, the decision of the examiner to reject claim 33 under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Claim 34 is not anticipated by Wolniak. In that regard, Wolniak does not disclose a first wall attached to the first spacing component which together with a wall of the container defines a chamber within the container capable of having an ice fishing tip-up placed therein. As such, the claimed ice fishing tackle storage system is not disclosed by Wolniak.

For the reason set forth above claim 34 is not anticipated by Wolniak. Accordingly, the decision of the examiner to reject claim 34 under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Claim 37 is not anticipated by Wolniak. In that regard, Wolniak does not disclose a container having a closed bottom end. Instead, Wolniak teaches a bottom panel 13 with holes 22. As such, the claimed ice fishing tackle storage apparatus is not disclosed by Wolniak.

For the reasons set forth above claim 37 is not anticipated by Wolniak. Accordingly, the decision of the examiner to reject claim 37, and claim 38 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by Wolniak is reversed.

Rejection 3

We will not sustain the rejection of claims 19, 21 to 23, 39 and 41 under 35 U.S.C. § 102(b) as being anticipated by McEwen.

Claims 19 and 23 read as follows:

19. An ice fishing tackle storage apparatus, the apparatus comprising:
 - a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;
 - a spacing structure, the elongate shells secured by the spacing structure the spacing structure effective to maintain two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure; and
 - wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.
23. An ice fishing tackle storage apparatus, the apparatus comprising:
 - a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;
 - a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain at least two of the elongate shells in predetermined relation to each other, proximate the spacing structure; and

a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, the plurality of legs attached to the spacing structure or to any of the elongate shells.

McEwen's invention relates to fishing generally and, in particular, to rod holders and supports therefor. Figure 1 shows a bucket 10 having a handle 12 carried by a hand H of a fisher. The bucket 10 also has a lid 14 which may be removed therefrom for the purpose of placing either bait or caught fish inside. If the bucket 10 contains some water, it serves as a "live well" for carrying the bait or fish. Also, because water is relatively heavy, the bucket 10 is steady when placed on the ground.

Dual tubes 16 and 18 are attached upright to the bucket 10. A pair of first sleeves 20 and 22 are attached to bolts 24 and 26, respectively, which are shown protruding from tubes 16 and 18, respectively. A pair of second sleeves 30 and 32 are slipped over upper ends of the tubes 16 and 18, respectively. The second sleeves 30 and 32 are attached by elastic cords 34 and 36, respectively, to a roller 28 which is positioned at the apex of the handle 12. The elastic cords 34 and 36 may be either two separate short cords or a single long cord extending inside the roller 28 for connecting the second sleeves 30 and 32 together at opposite ends of the same long cord. Thus, Figure 1 shows that the invention is portable by a single hand H in its disassembled condition.

Figures 2, 7 and 8 show the invention in its assembled condition. The bucket 10 rests on the ground G. Tubes 16 and 18 are fastened pivotally at their lower ends by a bolt and nut arrangements 38 near to a bottom edge 11 of the bucket 10. At their upper ends, the tubes 16 and 18 are open and each can support a handle portion of a conventional rod and reel fishing pole P having a line L. The tubes 16 and 18 are inclined towards the water (not shown) at an angle A selected by the fisher from a vertical axis Y of the bucket 10. The tube 16 is retained in its inclined position by the first sleeve 20 and the second sleeve 30. The first sleeve 20 is secured at a midsection of the tube 16 by the bolt 24 that is, in turn, clamped to two pivotable front legs 40 and 42. Together, the tube 16 and the front legs 40, 42 form a tripod for holding the fishing pole P by its handle at the selected angle A. The tube 18 is retained in its inclined position by the first sleeve 22 and the second sleeve 33 in a similar manner.

Initially, the bucket 10 is placed on the ground G. The bolt and nut arrangement 38 is tightened to make the bucket 10 leakproof. The bucket 10 is then filled with water to a desired level. Thereafter, the first sleeve 20 is slipped over the upper end of the tube 16 and is slid down to the midsection thereof. The angle A is then selected by the fisher and the bolt 24 is tightened against the tube 16 by whirling the front legs 40 and 42 therearound. The front legs 40 and 42 are then spread apart to form a tripod with the tube 16. Next, the elastic cord 34 is stretched from the roller 28 so that the second

sleeve 30 may be slipped over the upper end of the tube 16. Tube 18 is inclined in a similar manner. The handle 12 of the bucket 10 is then rotated above the lid 14 to a position where a fishing pole (not shown) may be inserted into the upper end of the tube 16. Thereafter, a second fishing pole (also not shown) may be inserted in the upper end of the second tube 18. Because the bucket 10 is partially filled with water, the fishing poles will be steady in the upper ends of the tubes 16 and 18.

Claim 19 is not anticipated by McEwen. In that regard, McEwen does not disclose that his tubes 16 and 18 are capable of serving as legs that will stably support the apparatus on a surface when the tubes are positioned in contact with the surface. As such, the claimed ice fishing tackle storage apparatus is not disclosed by McEwen.

For the reasons set forth above claim 19 is not anticipated by McEwen. Accordingly, the decision of the examiner to reject claim 19, and claims 21, 22 and 39 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by McEwen is reversed.

Claim 23 is not anticipated by McEwen. In that regard, McEwen does not disclose a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface wherein the plurality of legs are

attached to the spacing structure or to any of the elongate shells. As such, the claimed ice fishing tackle storage apparatus is not disclosed by McEwen.

For the reasons set forth above claim 23 is not anticipated by McEwen. Accordingly, the decision of the examiner to reject claim 23, and claim 41 dependent thereon, under 35 U.S.C. § 102(b) as being anticipated by McEwen is reversed.

Rejection 4

We will not sustain the rejection of claim 3 under 35 U.S.C. § 103 as being unpatentable over Thibodeaux in view of Morin. We have reviewed the reference to Morin applied in the rejection of dependent claim 3 but find nothing therein which makes up for the deficiency of Thibodeaux discussed above with respect to independent claim 1. Accordingly, we cannot sustain the examiner's rejection of claim 3 under 35 U.S.C. § 103.

Rejection 5

We will not sustain the rejection of claims 27 to 29 under 35 U.S.C. § 103 as being unpatentable over Thibodeaux. We find nothing in Thibodeaux that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Thibodeaux to makes up for the deficiency of Thibodeaux

discussed above with respect to independent claim 1. Accordingly, we cannot sustain the examiner's rejection of claims 27 to 29 under 35 U.S.C. § 103.

Rejection 6

We will not sustain the rejection of claims 1, 4 to 6, 16 and 43 under 35 U.S.C. § 103 as being unpatentable over Wolniak in view of Thibodeaux.

In this rejection under 35 U.S.C. § 103, the examiner (final rejection, pp. 5-6) determined that it would have been obvious to make Wolniak's tubes 30 adjustable in view of the adjustable length tubes of Thibodeaux. However, Thibodeaux does not teach adjustable length tubes for the reasons set forth above. As such, the subject matter of claims 1, 4 to 6 and 16 is not suggested by the teachings of the applied prior art.

As to claim 43, neither Wolniak nor Thibodeaux discloses or suggests a bucket. As such, the subject matter of claim 43 is not suggested by the teachings of the applied prior art.

For the reasons set forth above, the decision of the examiner to reject claims 1, 4 to 6, 16 and 43 under 35 U.S.C. § 103 is reversed.

Rejection 7

We will not sustain the rejection of claim 20 under 35 U.S.C. § 103 as being unpatentable over McEwen. We find nothing in McEwen that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified McEwen to make up for the deficiency of McEwen discussed above with respect to independent claim 19. Accordingly, we cannot sustain the examiner's rejection of claim 20 under 35 U.S.C. § 103.

Rejection 8

We will not sustain the rejection of claim 35 under 35 U.S.C. § 103 as being unpatentable over Wolniak. We find nothing in Wolniak that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Wolniak to make up for the deficiency of Wolniak discussed above with respect to independent claim 34.

We will not sustain the rejection of claim 36 under 35 U.S.C. § 103 as being unpatentable over Wolniak.

In the rejection of claim 36, the examiner (1) took Official Notice that rounded surfaces were old and well known on fishing tackle storage devices; and (2) concluded

that it would have been obvious to employ a rounded surface on the proximal end of each of Wolniak's tubes 30. The appellant seasonably challenged the taking of Official Notice. The examiner cited a patent (answer, p. 11) to support the taking of Official Notice but did not apply that patent in the rejection under appeal.

Based on the evidence applied in this ground of rejection (i.e., Wolniak alone), we are constrained to conclude that the evidence does not establish that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have employed a rounded surface on the proximal end of each of Wolniak's tubes 30. Accordingly, the examiner has failed to establish a prima facie case of obviousness with respect to claim 36.

For the reasons set forth above, the decision of the examiner to reject claims 35 and 36 under 35 U.S.C. § 103 is reversed.

Rejection 9

We will not sustain the rejection of claims 40 and 42 under 35 U.S.C. § 103 as being unpatentable over McEwen in view of Wolniak. We have reviewed the reference to Wolniak applied in the rejection of dependent claims 40 and 42 but find nothing therein which makes up for the deficiency of McEwen discussed above with respect to

independent claims 19 and 23. Accordingly, we cannot sustain the examiner's rejection of claims 40 and 42 under 35 U.S.C. § 103.

REMAND

We remand this application to the examiner to ascertain whether or not claim 19 is anticipated by Wolniak. Specifically, the examiner should determine if the claimed language of "wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure" is readable on Wolniak's teaching (column 3, lines 52-58) that the entire tube display assembly may be lifted from the container portion, if desired.

CONCLUSION

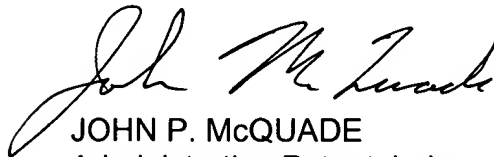
To summarize, the decision of the examiner to reject claims 1, 2, 7 to 9 and 24 to 26 under 35 U.S.C. § 102(e) is reversed; the decision of the examiner to reject claims 10 to 15, 17 to 19, 21 to 23, 30 to 34, 37 to 39 and 41 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1, 3 to 6, 16, 20, 27 to 29, 35, 36, 40, 42 and 43 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further action.

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REVERSED & REMANDED



IRWIN CHARLES COHEN
Administrative Patent Judge



JOHN P. McQUADE
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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